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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,148	12/02/2003	Koji Yoshimura	PF613TD1	4267

7590 04/28/2004

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Maryam Monshipouri

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 5, 7-8, 11-13, 15-18, drawn to ADAM polypeptides having SEQ ID NO:2, DNA sequences encoding said polypeptides, vectors and host cells comprising said DNA sequences, methods of expressing said sequences and compositions comprising said products.

Group II, claim(s) 4, drawn to ADAM polypeptides having SEQ ID NO:1.

Group III, claim(s) 4, drawn to ADAM polypeptides having SEQ ID NO:15.

Group IV, claim(s) 6, 9-10, 16-18, drawn to partial peptides having SEQ ID NO:6, DNA sequences encoding said peptides, and compositions comprising said peptides.

Group V, claim(s) 14, drawn to antibodies which bind SEQ ID NO:2.

Group VI, claim(s) 14, drawn antibodies which bind SEQ ID NO:6.

Group VII, claim(s) 19-22, drawn to methods of screening inhibitors of SEQ ID NO:2, said inhibitors and compositions comprising said inhibitors.

Group VIII, claim(s) 23-26, drawn to agents comprising SEQ ID NO:5 .

Group IX, claim(s) 27-30, and 33-34 drawn to methods of screening for inhibitors of SEQ ID NO:5 and kits and compositions comprising said inhibitors.

Group X, claim(s) 31, drawn to agents comprising antibodies which bind SEQ ID NO:5.

Group XI, claim(s) 32, drawn to methods of detecting a proteoglycan enzyme encoding gene using test gene.

Group XII, claim(s) 35-36, drawn to transgenic non-human mammals comprising genes encoding SEQ ID NO:2 and a method of use of said mammal.

The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical features of inventions I-XII are SEQ ID NO:2, SEQ ID NO:1, SEQ ID NO:15, SEQ ID NO:6, antibodies which bind SEQ ID NO:2, antibodies which bind SEQ ID NO:6, inhibitors of SEQ ID NO:2, SEQ ID NO:5, inhibitors of SEQ ID NO:5, antibodies of SEQ ID NO:5, test gene and transgenic mammals respectively, which are each directed to a product of unrelated structure and function.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnanthapu Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Maryam Monshipouri ph.D.

Primary Examiner
